

**REMARKS****ENTRY OF AMENDMENT UNDER 37 C.F.R. § 1.116:**

Applicants request entry of this Rule 116 Response because the amendment of claim 11 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised; and the amendment does not significantly alter the scope of the claims and place the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the application either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

**INTRODUCTION:**

In accordance with the foregoing, claim 11 has been amended to improve clarity and antecedent support. No new matter is being presented, and approval and entry are respectfully requested.

Claims 11-43 are pending and under consideration.

**REJECTION UNDER DOUBLE PATENTING:**

In the Office Action, at page 3, claims 11-12, 15-23, 39, and 41 were rejected under the judicially created doctrine of provisional obviousness-type double patenting as being unpatentable over claims 1, 2, 15-17, 20-21, 23, 25, 27, and 45 of copending application No. 09/337,253, parent application of the above-referenced application. Further, claims 13-14 and 24-38, 40, and 42-43 were rejected under the judicially created doctrine of provisional obviousness-type double patenting as being unpatentable over claims 1, 3, 15-17, 20-21, 23, 25, 27, and 45 of copending application No. 09/337,253 in view of U.S. Patent No. 6,038,366 to Ohno et al. Claims 11-43 were rejected under the judicially created doctrine of provisional obviousness-type double patenting as being unpatentable over claims 4-5, 7, 16-31, 33-39, 40-41, and 44 of copending application No. 9/610,380, divisional application of the above-referenced application. Applicants will address the provisional obviousness-type double

patenting rejections once the pending rejections to the claims are resolved.

**REJECTION UNDER 35 U.S.C. § 103:**

*In the Office Action, at page 20, claims 11-43 were rejected under 35 U.S.C. § 103 in view of U.S. Patent No. 6,038,366 to Ohno et al. ("Ohno") in view of U.S. Patent No. 5,758,355 to Buchanan ("Buchanan"). This rejection is traversed and reconsideration is requested.*

The Office Action correctly recognized that Ohno fails to teach or suggest "recording an identification information of a manufacturer of a recording apparatus that recorded or modified the content of the recording medium different from the identification information prior to the recording or the modification," as recited in independent claim 11. Accordingly, the Office Action relies on Buchanan as teaching such a claimed feature.

Buchanan generally describes a server including a plurality of tables, which is accessible on a server computer system. See abstract. The server includes storage media encoded with the server database. See column 4, lines 22-26. According to Buchanan, company records, for example, may indicate not only which companies are associated with a particular team, but also may identify records in a contact table that specify the contact persons at the company. See column 2, lines 33-37. The Contact Table of Buchanan includes contact id., first name, last name, company id., row id., modify date, and modify employee. See column 8, lines 40-50. However, similarly to Ohno, Buchanan fails to teach or suggest, "recording an **identification information of a manufacturer of a recording apparatus**," emphasis added, as recited in independent claim 11. Rather, the Contact Table appears to merely list employees of different companies modifying a company's records. There is no teaching or suggestion in Buchanan that the Contact Table stores "identification information of a manufacturer of a recording apparatus," as recited in independent claim 11. The identification information includes employees modifying records that are related to a team for which an associated remote employee is included. See column 7, lines 47-52. Furthermore, Buchanan fails to teach or suggest "an identification information of a manufacturer of a recording apparatus **that recorded or modified the content of the recording medium different from the identification information prior to the recording or the modification**," emphasis added, as recited in independent claim 11.

Accordingly, Buchanan and Ohno, individually or combined, fail to teach or suggest all the claimed features of independent claim 11 and related dependent claims. It is respectfully

asserted that independent claims 11 and related dependent claim 12 are allowable in view of the prior art of record.

Without adequate support from Ohno and/or Buchanan of a need or motivation to achieve an efficient system operation in Ohno, the Office Action indicates that “it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the identification as taught by Buchanan into Ohno’s system in order to allow the user to know who modif[ied] the content of the record.” Rather than using the teachings of the cited references, the Office Action combines the references by disregarding current case law regarding the standard of an obviousness rejection under 35 U.S.C. § 103.

It is improper to merely deem something obvious without any teaching/suggestion from the cited references. As applied to the determination of patentability when the issue is obviousness, “it is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section.” See In re Lee, 61 USPQ2d 1430 (Fed. Cir. 2002), (citing In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983)). The essential factual evidence on the issue of obviousness is set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See In re Lee, 61 USPQ2d 1430 (CA FC 2002), (citing McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) (“The central question is whether there is reason to combine [the] references,” a question of fact drawing on the Graham factors). Accordingly, evidence must be provided from the prior art of some teaching, motivation, or suggestion to select and combine the references.

Thus, as pointed out in In re Lee, the record must support motivation, i.e., there must be something in the record pointing out where the recited motivation can be found. In addition, there must be some discussion on how that purported motivation or suggestion is even relevant to the reference being modified.

It is the Applicants’ position that only the present invention sets forth all the claimed features, as well as the motivation for combining the same. The outstanding rejection would appear to have taken the teachings of the present invention and applied the same to generate a combination of Ohno and Buchanan as set forth in the Office Action. In view of the foregoing, it

is respectfully requested that independent claim 11 and related dependent claim 12 be allowed.

Referring to independent claim 13, according to the Office Action, column 6 of Ohno, lines 18-31, teaches the claimed features of independent claim 13. The referred portion of Ohno describes a control procedure where a preliminary play-back operation is carried out to read out tape map information recorded in a video signal. Specifically, the control procedure checks whether the VTR manufacture number data as fetched from the tape coincides with the VTR manufacture number stored in the library memory 4 shown in FIG. 1. Unless coincidence is found, this control processing is terminated. The tape map information, as described by Ohno, concerns the contents of program(s) recorded on the loaded tape, temporal duration(s) of the program(s), and history of play-back of the tape. See abstract.

However, the tape map information does not include "an identification code of a manufacturer of a device which last modified the content of the recording medium," as recited in independent claim 13. Nowhere in the referred portion of Ohno, or anywhere else in the reference, is there a teaching or suggestion of the claimed features of independent claim 13. Specifically, Ohno fails to teach or suggest "verifying a coincidence of an identification code of a manufacturer of a device which last modified the content of the recording medium and the manufacturer identification code of the recording/reproducing apparatus to determine whether manufacturer specific information of the recording/reproducing apparatus is effective," as recited in independent claim 13.

Furthermore, the Office Action correctly recognized that Ohno fails to teach or suggest, "the identification information of the manufacturer is different from the identification information prior to the recording or the modification," as recited in independent claim 13. Accordingly, the Office Action refers to similar portions of Buchanan to reject this claimed feature of independent claim 13 as the portions of the cited references previously discussed and distinguished from the claimed features of independent claim 11. The arguments presented above supporting the patentability of independent claim 11 in view of Buchanan are incorporated herein to support the patentability of independent 13 and related dependent claim 14. In view of the foregoing, it is respectfully requested that independent claim 13 and related dependent claim 14 be allowed.

Likewise, the Office Action refers to similar portions of the cited references to reject independent claims 15, 28, and 31 as the portions of the cited references previously discussed and distinguished from the claimed features of independent claims 11 and 13. The arguments presented above supporting the patentability of independent claims 11 and 13 in view of Ohno and/or Buchanan are incorporated herein to support the patentability of independent claims 15,

28, and 31. Accordingly, Ohno and/or Buchanan, individually or combined, fail to teach or suggest all the claimed features of independent claims 11, 13, 15, 28, and 31. It is respectfully requested that independent claims 11, 13, 15, 28, and 31 and related dependent claims be allowed.

On page 17 of the Office Action, it is indicated that "the capability of compressing information using variable length is old and well known in the art and therefore Official Notice is taken." While "official notice" may be relied upon, as noted in MPEP §2144.03, these circumstances should be rare when an application is under final rejection or action under 37 CFR §1.113. Accordingly, if the U.S. Patent and Trademark Office wishes to take Official Notice that the proposed structural and functional modification is notoriously well known, it is respectfully requested that supporting evidence be provided. The Federal Circuit has cautioned that an Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. In re Rouffet, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998).

#### **CONCLUSION:**

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

Please AMEND claim 11:

11. (THREE TIMES AMENDED) A method of recording and/or editing content on a data [storage] recording medium, comprising:

recording an identification information of a manufacturer of a recording apparatus that recorded or modified the content of the recording medium different from the identification information prior to the recording or the modification.